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EXAMINER

SHIMIZU, MATSUICHIRO

ART UNIT PAPER NUMBER

2635

DATE MAILED: 12/14/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/524,804

Applicant(s)

TUTTLE, MARK E.

Examiner

Matsuichiro Shimizu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 50-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

The examiner acknowledges canceled claims 1-49 and new claims 50-85.

***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 53-85 have been renumbered claims 50-82.

***Informalities***

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 109 (e) or 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

An application is a continuation of 08/920,329 08/20/1997 PAT 6,052,062.

2. The disclosure is objected to because of the following informalities: page 15, line 11 "then" should be "than".

Appropriate correction is required.

***Abstract***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed

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250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The word phrase "the present invention" should be avoided.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 50-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-49 of U.S. Patent No. 6,052,062. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

√ Regarding claims 50 and 66, PAT-062 claims a remote intelligent communication device comprising: housing including an upper surface, a lower surface, and at least one side intermediate the upper surface and the lower surface and having a dimension less than smallest dimensions of the upper surface and the lower surface, and the at least one side surface having visibly perceptible indicia thereon; and communication circuitry within the housing and the

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communication circuitry being configured to communicate wireless signals in claim 1. But PAT-062 does not claim a wireless communication device.

However, one skilled in the art recognizes that card-thin housing devices are well known in the art to be wireless communication devices. Therefore, it would have been obvious as evidenced by its conventionality to include a wireless communication device in the device of PAT-062 because PAT-062 suggests a remote intelligent communication device with a card-thin housing in claim 1 and one skilled in the art recognizes a communication device with a card-thin housing is typically a wireless communication device.

Regarding claims 51 and 67-68, PAT-062 claims the housing comprises an encapsulant which contacts the communication circuitry in claim 2.

Regarding claims 52 and 69, PAT-062 claims the at least one side surface has a dimension less than about 100 mils in claim 4.

Regarding claims 53 and 70, since claim 6 in PAT-062 is equivalent to combination of applicants' claims 50 and 53 with claim 6 in its entirety, PAT-062 claims the communication circuitry comprises RFID device circuitry in claim 6.

Regarding claims 54 and 71, PAT-062 claims a communication device comprising: a substrate; communication circuitry; and an encapsulant elevationally over the support surface and configured to encapsulate at least portions of the support surface of the substrate and the communication circuitry, and wherein the encapsulant and the substrate respectively define an upper surface and a lower surface and have a thickness less than a smallest dimension of the at least one perimetral edge, and the encapsulant includes visibly perceptible indicia intermediate

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the upper surface and the lower surface in claim 19. But PAT-062 does not claim a wireless communication device.

However, one skilled in the art recognizes that communication devices are well known in the art to be wireless communication devices. Therefore, it would have been obvious as evidenced by its conventionality to include a wireless communication device in the device of PAT-062 because PAT-062 suggests a communication device in claim 19 and one skilled in the art recognizes a communication device is typically a wireless communication device.

✓ Regarding claims 55 and 72, PAT-062 claims a housing having an upper surface and a lower surface interconnected by side surfaces, the side surfaces individually having a dimension less than smallest dimensions of the upper and lower surfaces in claim 19. But PAT-062 does not claim a surface substantially in the shape of a rectangle.

However, one skilled in the art recognizes that a housing having an upper surface and a lower surface interconnected by side surfaces, the side surfaces individually having a dimension less than smallest dimensions of the upper and lower surfaces is well known in the art to be a surface substantially in the shape of a rectangle. Therefore, it would have been obvious as evidenced by its conventionality to include a surface substantially in the shape of a rectangle in the device of PAT-062 because PAT-062 suggests a housing having an upper surface and a lower surface interconnected by side surfaces, the side surfaces individually having a dimension less than smallest dimensions of the upper and lower surfaces in claim 19 and one skilled in the art recognizes a housing having an upper surface and a lower surface interconnected by side surfaces, the side surfaces individually having a dimension less than smallest dimensions of the upper and lower surfaces is typically a surface substantially in the shape of a rectangle..

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Regarding claims 56 and 73, PAT-062 claims the cured resin and substrate forming a housing is equivalent to encapsulant contacts at least portions of the support surface and the communication circuitry in claim 19.

Regarding claims 57 and 74, PAT-062 claims the encapsulant and the substrate have a thickness less than about 100mils in claim 20.

Regarding claims 58 and 75, since combination of claims 6 and 10-11 in PAT-062 is equivalent to combination of applicants' claims 54 and 56, PAT-062 claims the communication circuitry comprises RFID device circuitry in claim 6.

✓ Regarding claims 59 and 76, PAT-062 claims a remote intelligent communication device comprising: communication circuitry configured to communicate wireless signals; and an encapsulant configured to encapsulate and contact at least a portion of the communication circuitry, wherein the encapsulant defines at least one side surface and the at least one side surface has visibly perceptible information thereon in claims 34. But PAT-062 does not claim a wireless communication device.

However, one skilled in the art recognizes that a remote intelligent communication device is well known in the art to be wireless communication devices. Therefore, it would have been obvious as evidenced by its conventionality to include a wireless communication device in the device of PAT-062 because PAT-062 suggests a remote intelligent communication device in claim 34 and one skilled in the art recognizes a remote intelligent communication device is typically wireless communication device.

Regarding claims 60 and 77, PAT-062 claims the encapsulant has a dimension less than about 100 mils in claim 36.

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Regarding claims 61 and 78, PAT-062 claims the communication circuitry comprises RFID device circuitry in claim 38.

✓ Regarding claims 62 and 79, PAT-062 claims a RFID device (claim 6) comprising: a housing including an upper surface and a lower surface which define a housing thickness of less than about 50 mils (claim 8) intermediate the lower surface and the upper surface, and the housing has visibly perceptible indicia thereon intermediate the upper surface and the lower surface; and communication circuitry within the housing and configured to communicate wireless signals (claims 6-7). But PAT-062 does not claim a housing thickness of less than about 100 mils.

However, one skilled in the art recognizes that a housing thickness of less than about 50 mils (claim 8) is within the range associated with a housing thickness of less than about 100 mils. Therefore, it would have been obvious to a person skilled in the art at the time of invention was made to include a housing thickness of less than about 100 mils is a matter of choice in design through routine experimentation in order to achieve optimum housing design.

Regarding claim 63 and 80, PAT-062 claims the housing comprises an encapsulant which contacts at least portions of the support surface and the communication circuitry in claim 10.

Regarding claim 64, PAT-062 claims a RFID device (claim 6). But PAT-062 does not claim an antenna within the housing and coupled with the communication circuitry in claim 6.

However, one skilled in the art recognizes that a RFID device is well known in the art to contain an antenna. Therefore, it would have been obvious as evidenced by its conventionality to include an antenna in the device of PAT-062 because PAT-062 suggests a RFID in claim 6 and one skilled in the art recognizes an antenna as a part within the RFID.



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Regarding claims 65 and 82, PAT-062 claims a transponder device (claim 19) comprising: a substrate having a support surface (claim 19); transponder device circuitry elevationally over the support surface and configured to communicate wireless signals (claim 19); a power source elevationally over the support surface and coupled with the transponder device circuitry (claim 19); an antenna (claim 19); and an encapsulant contacting at least portions of the support surface (claim 19), and the at least one side surface includes visibly perceptible indicia (claim 19). But PAT-062 does not claim RFID device.

However, one skilled in the art recognizes that a transponder device is well known in the art to be a RFID. Therefore, it would have been obvious as evidenced by its conventionality to include a RFID device in the device of PAT-062 because PAT-062 suggests a transponder device in claim 19 and one skilled in the art recognizes a RFID device by its conventionality.

Regarding claim 81, PAT-062 continues, as claimed in claim 80, to claim a RFID device in claim 6.

***Claim Rejections - 35 USC § 103***

1. Claims 59 and 76 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Neustein (5,192,947) in view of Lebby et al. (5,493,437) and Blok et al. (4,461,793).

Regarding claims 59 and 76, Neustein discloses a wireless communication device (col. 1, lines 65-68, credit card pager) comprising: communication circuitry (Fig. 2, col. 4, lines 43-45, pager receiver) with indicia there on (16; Fig. 1; col. 5, lines 5-10 and 35-38). But Neustein does not disclose an encapsulant configured to encapsulate and contact at least a portion of the communication circuitry, wherein the encapsulant defines at least one side surface and the at least one side surface has visibly perceptible information thereon.

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However, Lebby discloses, in the art of credit card pager, encapsulation of communication circuitry (col. 3, lines 13-26, encapsulating the inner component of pager) molded in the form of credit card pager in order to provide ruggedized structure. Therefore, it would have been obvious to a person at the time of invention to include encapsulation of communication circuitry in the device of Neustein as evidenced by Lebby because Neustein suggests molding the circuit to give appearance of regular credit cards and Lebby teaches encapsulation of communication circuitry molded in the form of credit card pager in order to provide ruggedized structure.

Likewise, Blok discloses, in the art of encapsulating devices, providing indicia on the surface of encapsulant (Fig. 4, col. 3, lines 40-44, indicia (12) on the surface of encapsulation) in order to identify the device. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to include at least one side surface and the at least one side surface has visibly perceptible information on the surface of encapsulation in the device of Neustein as evidenced by Blok because Neustein suggests providing indicia on the pager device molded in the form of regular credit card and Lebby suggests such credit card paging devices are encapsulated, and Blok teaches indicia on the surface of encapsulation (or molding) in order to identify the device.

Regarding claims 60 and 77, Neustein discloses the encapslant has a dimension less than about 100 mils (Fig. 1a, col. 4, lines 66-68, one-tenth of an inch or 100 mils).

Regarding claims 61 and 78, Neustein discloses credit card pager (Abstract, lines 1-19). But Neustein does not disclose RFID device circuitry.

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However, Neustein discloses RFID device circuitry (Fig.2, col. 6, lines 1-19, receiver (48), digital microprocessor (52)).

### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matsuichiro Shimizu whose telephone number is (703) 306-5841. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Micheal Horabik, can be reached on (703-305-4704). The fax phone number for the organization where this application or proceeding is assigned is (703-305-3988).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-8576).

Matsuichiro Shimizu

December 11, 2001

MICHAEL HORABIK  
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